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10/081,715	02/20/2002	Lowell Potiker	4728-101	1257

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EXAMINER	
DURAN, ARTHUR D	

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
08/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/081,715	POTIKER, LOWELL	
	Examiner	Art Unit	
	Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 8/3/07.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-24 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-24 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-24 have been examined.

Response to Amendment

2. The Amendment filed on 8/3/07 is sufficient to overcome the prior rejection. A new reference has been added.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rubstein (20030061566) in view of Nishi (6,144,940) in view of Finch (5,091,634).

Claims 1, 13: Rubstein discloses a method for issuing and redeeming a certificate over a network in conjunction with an interactive voice response system, comprising:

receiving information related to a certificate the user is purchasing over the network;

creating the certificate based on the received information, the certificate including the name of the merchant at which the certificate can be redeemed and a certificate identifier;

transmitting the certificate to the user over the network;

receiving a merchant identification in response to a call from a caller to the interactive voice response system to redeem the certificate;

validating that the merchant identification is valid;

instructing the interactive voice response system to request the caller to enter the certificate identifier if the merchant identification is valid;

receiving the certificate identifier entered by the caller over the network; and

validating the certificate based on the received certificate identifier (Paragraphs [45, 62, 63, 64]).

Also, note in Rubstein that the supplier can be a store ([63], "supplier of the gift product (e.g., a store)").

Additionally, the combination of the prior art renders obvious receiving or validating the merchant's identity, verifying the accuracy of the entered certificate identifier, or generating codes to the interactive voice response system to cause it to generate selected voice messages for indicating, among other things, that the certificate is not valid at the identified merchant.

And, the combination of the prior art renders obvious:

1) "receiving a merchant identification in response to a call from a caller to the interactive voice response system to redeem the certificate",

2) "validating that the merchant identification is valid",

3) "the interactive voice response system generating a voice message repeating the certificate identifier to the caller in response to the receipt of a message from the caller indicative of the certificate identifier",

4) "the interactive voice response system generating a voice message requesting the caller to verify the repeated certificate identifier",

5) "generating at least one of a plurality of codes to the interactive voice response system

regarding the validity of the certificate",

6) "the interactive voice response system generating a selected voice message and transmitting it to the caller in response to the generated at least one code", and

7) "one of the plurality of codes indicating that the certificate is not valid at the identified merchant".

Rubstein disclose receiving or validating the merchant's identity. Rubstein discloses that the voucher/certificate can only be redeemed at the appropriate or specific store(s). And, Rubstein discloses that the store id identified by the "Store Code". And, Rubstein discloses that the unique number for each certificate provides access to the other information relevant to the certificate including the "Store Code":

"[45]...After the greeting card has been personalized and sent to the recipient, the recipient can download the voucher to redeem the gift from the appropriate source

[0048] Referring to FIG. 5, all the unique data of the card such as Type and ID of the card, Serial number and Personal Message text is stored in the last block 56 of 32 bytes in the card customization area. It is filled with default values during creation of the card. Then the Type, ID and Serial Number, Store Code, Creation Date and other parameters are set up by a special program before the card file 46 is delivered to the purchaser. The Type contains data that controls whether personal messages may be allowed to be entered and if duplicated copies of the card file 46 can be used (and how many times it can be reused) and ID represents the coded name of the card. The Type and ID are set up on a Windows based software before uploading to the server. Alternatively,

the Type and ID are set up at the server so as to give the vendor better control of the compatibility of the data format. The Serial Number, which is a time-based random generated number, is assigned to the card file by the server software just before the customer can start downloading the card file. Thus, each card file received by the purchaser comes with a unique identification number, which may be a Serial Number in the example given above.

[50]... // Store Code -4 bytes

[63]... The recipient can then apply the voucher to a designated supplier of the gift product (e.g., a store). The supplier will verify with the card vendor (e.g., by contacting online the card vendor's website with the voucher number and/or card identification number or via an automated telephone verification system whereby the supplier would key in the voucher number and card identification code using the telephone touch tone key pad) to authenticate the voucher number and/or the card identification code so as to ensure that the gift has not already been redeemed by the recipient.

[64]...Alternatively, a password may be issued to the recipient so that she could use the password in conjunction with the voucher number to redeem the gift from a designated supplier. The supplier maintains a list of eligible passwords for verification purposes or contacts the card vendor to verify the password and voucher number. "

Hence, Rubstein renders obvious that the merchant needs to be uniquely identified because each certificate only works at certain stores identified by the "Store Code".

Rubstein further discloses an "automated telephone verification system" for veryifying vouchers/certificates ([63]). Rubstein further discloses verifying the certificate ([52, 62, 64]).

Rubstein does not explicitly disclose repeating the information back to the caller or different codes for the different valid or invalid indications related to a certificate.

However, Nishi discloses repeating the information back to the caller (Figure 2; 'confirmation message', 'correction?'; col 1, lines 30-35). Also, note that Nishi is oriented towards receiving requests by speech such as by telephone for a variety of processing (col 1,lines 5-10; Title; Abstract). Also, Nishi discloses receiving or validating the merchant's identity (Figure 3, 'serial store number'; col 7, lines 45-50), verifying the accuracy of the entered certificate identifier (Figure 2; 'confirmation message', 'correction?'; col 1, lines 30-35), or generating codes to the interactive voice response system to cause it to generate selected voice messages for indicating, among other things, that the certificate is not valid at the identified merchant (Figure 2;). Also, Nishi discloses 1) "receiving a merchant identification in response to a call from a caller to the interactive voice response system to redeem the certificate" (Figure 3, 'serial store number'; col 7, lines 45-50), 2) "validating that the merchant identification is valid" (Figure 3, 'serial store number'; col 7, lines 45-50), 3) "the interactive voice response system generating a voice message repeating the certificate identifier to the caller in response to the receipt of a message from the caller indicative of the certificate identifier" (Figure 2; 'confirmation message', 'correction?'; col 1, lines 30-35), 4) "the interactive voice response system generating a voice message requesting the caller to verify the repeated certificate identifier" (Figure 2; 'confirmation message', 'correction?'; col 1, lines 30-35).

And, Finch discloses different codes for the different valid or invalid indications related

to a certificate (col 4, lines 30-46; claims 5, 19). Also, Finch discloses utilizing telephone systems (col 3, lines 50-56). Finch further discloses 5) "generating at least one of a plurality of codes to the interactive voice response system regarding the validity of the certificate", 6) "the interactive voice response system generating a selected voice message and transmitting it to the caller in response to the generated at least one code", and 7) "one of the plurality of codes indicating that the certificate is not valid at the identified merchant" (col 4, lines 30-46; claims 5, 19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Nishi's repeating information and Finch's different coupon verification codes to Rubstein's verifying critical information over the phone and determining the valid or invalid status of certificates. One would have been motivated to do this in order to better verify information over the phone and better indicate the status of certificates.

Claims 2, 14, 12, 24: Rubstein discloses a method according to claim 11, further comprising storing the certificate identifier, the merchant identification and the conditions for redeeming the certificate in a database and referring to the database to determine whether the certificate can be redeemed ([45, 62, 63, 64]).

Claims 3, 15: Rubstein discloses a method according to claim 1, wherein the transmitting includes generating a graphic file of the certificate and sending the graphic file to the user with an electronic mail message ([5, 14]).

Claims 4, 16: Rubstein discloses a method according to claim 1, wherein the merchant identification is an identifier associated with the merchant named in the certificate ([48]).

Claims 5, 17, 6, 18: The combination of the prior art discloses the above. Rubstein does not explicitly disclose utilizing caller id to verify the identity of a merchant as stated in Applicant's Specification (Paragraph [19]) or claims 5, 17, 6, 18. However, Rubstein further discloses unique phone numbers to call, unique merchant/store identification, passwords for verification ([45, 48, 62-64). Also, Nishi discloses that merchant phone number can be known and part of identification information (Figure 3; col 9, lines 15-20).

Therefore, it would be obvious to one skilled in the art that caller id can be used to identify parties, callers, or merchants. One would be motivated to use caller id because caller id was a readily available and well known service for identifying parties or callers at the time of the Applicant's invention.

Claims 7, 19: Rubstein discloses a method according to claim 1, further comprising instructing the interactive voice response system to request the caller to call a customer service number if the merchant identification is invalid ([63], contact customer service).

Claims 8, 20: Rubstein discloses a method according to claim 1, wherein the certificate identifier is entered via a touch tone pad ([63], 'key in').

Claims 9, 21: Rubstein discloses a method according to claim 1, wherein validating that the received certificate identifier is valid includes determining whether the certificate identifier is present in a database (45, 62, 63, 64).

Claims 10, 22: Rubstein discloses a method according to claim 1, wherein the certificate further includes conditions for redeeming the certificate ([63], 'only generated once'; [48], which store; [45], which product).

Claims 11, 23: Rubstein discloses a method according to claim 10, further comprising determining whether the certificate can be redeemed based on the conditions for redeeming the certificate ([62]; [63], 'only generated once'; [48], which store; [45], which product).

4. Claims 5, 17, 6, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rubstein (20030061566) in view of Nishi (6,144,940) in view of Finch (5,091,634) in view of Soderlind (2002/0069123).

The combination of the prior art discloses the above. Rubstein further discloses unique phone numbers to call, unique merchant/store identification, passwords for verification ([45, 48, 62-64).

Rubstein does not explicitly disclose utilizing caller id to verify the identity of a merchant as stated in Applicant's Specification (Paragraph [19]) or claims 5, 17, 6, 18.

However, Soderlind discloses utilizing caller id to verify the identity of a merchant (Paragraphs [20, 25]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Soderlind's caller id to verify the identity of a merchant to Rubstein's phone number to call, merchant/store id, password verification. One would have been motivated to do this in order to better identify the store.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Also, Examiner notes the following.

In Applicant's Remarks dated 8/3/07, Applicant states that the prior art does not render obvious:

"receiving or validating the merchant's identity, verifying the accuracy of the entered certificate identifier, or generating codes to the interactive voice response system to cause it to generate selected voice messages for indicating, among other things, that the certificate is not valid at the identified merchant."

Applicant further stated that the prior art does not render obvious:

1) "receiving a merchant identification in response to a call from a caller to the interactive voice response system to redeem the certificate",

2) "validating that the merchant identification is valid",

3) "the interactive voice response system generating a voice message repeating the certificate identifier to the caller in response to the receipt of a message from the caller indicative of the certificate identifier",

4) "the interactive voice response system generating a voice message requesting the caller to verify the repeated certificate identifier",

5) "generating at least one of a plurality of codes to the interactive voice response system regarding the validity of the certificate",

6) "the interactive voice response system generating a selected voice message and transmitting it to the caller in response to the generated at least one code", and

7) "one of the plurality of codes indicating that the certificate is not valid at the identified merchant".

However, Rubstein disclose receiving or validating the merchant's identity. Rubstein discloses that the voucher/certificate can only be redeemed at the appropriate or specific store(s). And, Rubstein discloses that the store id identified by the "Store Code". And, Rubstein discloses that the unique number for each certificate provides access to the other information relevant to the certificate including the "Store Code":

"[45]...After the greeting card has been personalized and sent to the recipient, the recipient can download the voucher to redeem the gift from the appropriate source

[0048] Referring to FIG. 5, all the unique data of the card such as Type and ID of the card, Serial number and Personal Message text is stored in the last block 56 of 32 bytes in the card customization area. It is filled with default values during creation of the card. Then the Type, ID and Serial Number, Store Code, Creation Date and other parameters are set up by a special program before the card file 46 is delivered to the purchaser. The Type contains data that controls whether personal messages may be allowed to be entered and if duplicated copies of the card file 46 can be used (and how many times it can be reused) and ID represents the coded name of the card. The Type and ID are set up on a Windows based software before uploading to the server. Alternatively, the Type and ID are set up at the server so as to give the vendor better control of the compatibility of the data format. The Serial Number, which is a time-based random generated number, is assigned to the card file by the server software just before the customer can start downloading the card file. Thus, each card file received by the purchaser comes with a unique identification

number, which may be a Serial Number in the example given above.

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[64]...Alternatively, a password may be issued to the recipient so that she could use the password in conjunction with the voucher number to redeem the gift from a designated supplier. The supplier maintains a list of eligible passwords for verification purposes or contacts the card vendor to verify the password and voucher number. "

Hence, Rubstein renders obvious that the merchant needs to be uniquely identified because each certificate only works at certain stores identified by the "Store Code".

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towards receiving requests by speech such as by telephone for a variety of processing (col 1,lines 5-10; Title; Abstract). Also, Nishi discloses receiving or validating the merchant's identity (Figure 3, 'serial store number'; col 7, lines 45-50), verifying the accuracy of the entered certificate identifier (Figure 2; 'confirmation message', 'correction?'; col 1, lines 30-35), or generating codes to the interactive voice response system to cause it to generate selected voice messages for indicating, among other things, that the certificate is not valid at the identified merchant (Figure 2;). Also, Nishi discloses 1) "receiving a merchant identification in response to a call from a caller to the interactive voice response system to redeem the certificate" (Figure 3, 'serial store number'; col 7, lines 45-50), 2) "validating that the merchant identification is valid" (Figure 3, 'serial store number'; col 7, lines 45-50), 3) "the interactive voice response system generating a voice message repeating the certificate identifier to the caller in response to the receipt of a message from the caller indicative of the certificate identifier" (Figure 2; 'confirmation message', 'correction?'; col 1, lines 30-35), 4) "the interactive voice response system generating a voice message requesting the caller to verify the repeated certificate identifier" (Figure 2; 'confirmation message', 'correction?'; col 1, lines 30-35).

And, Finch discloses different codes for the different valid or invalid indications related to a certificate (col 4, lines 30-46; claims 5, 19). Also, Finch discloses utilizing telephone systems (col 3, lines 50-56). Finch further discloses 5) "generating at least one of a plurality of codes to the interactive voice response system regarding the validity of the certificate", 6) "the interactive voice response system generating a selected voice message and transmitting it to the caller in response to the generated at least one code", and 7) "one of the plurality of codes

indicating that the certificate is not valid at the identified merchant" (col 4, lines 30-46; claims 5, 19).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Nishi's repeating information and Finch's different coupon verification codes to Rubstein's verifying critical information over the phone and determining the valid or invalid status of certificates. One would have been motivated to do this in order to better verify information over the phone and better indicate the status of certificates.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It must be presumed that the artisan knows something about the art apart from what the references disclose. In re Jacobv, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references

disclose. In re Jacoby. Also, the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. In re Bozek, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, USPQ 12 (CCPA 1977).

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

If a person of ordinary skill in the art can implement a predictable variation, and would see the benefit of doing so, §103 likely bars its patentability. Moreover, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. KSR Int'l Co. v. Teleflex, Inc., No 04-1350 (U.S. Apr. 30, 2007).

Also, KSR states that it is obvious to recite combination which only unite old elements with no change in their respective functions and which yield predictable results. KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

aa) Alpdemir (20020035474 and 6,658,389) disclose relevant features (Figures 1, 2, [285]);

a) Lee (20020032605) discloses telephone verified gift certificates (Paragraphs [8, 9, 27 37]);

b) Christensen (20030088461) discloses telephone verified gift certificates;

c) Messner, Small, Gillin, Karas, and Karas disclose telephone verified gift certificates.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

'Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran
Primary Examiner
Art Unit 3622

8/8/2007